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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/808,484 | 03/25/2004 | Colin C.O. Goble | 2558-78 | 5758 |
| 23117 | 7590 | 10/25/2005 | EXAMINER | |
| NIXON & VANDERHYE, PC | | | PATEL, NIHIR B | |
| 901 NORTH GLEBE ROAD, 11TH FLOOR | | | ART UNIT | |
| ARLINGTON, VA 22203 | | | PAPER NUMBER | |

3743

DATE MAILED: 10/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/808,484 | Applicant(s) GOBLE ET AL. | |
| | Examiner Nihir Patel | Art Unit 3743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 11th, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,758,846. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between **claim 1** of application and **claim 1 of patent '846** lies in the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 1 of patent '846 is in effect "specie" of the "generic" invention of claim 1 of the application. It has been held that the generic invention is "anticipated" by the "specie". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 1 of the application is anticipated by claim 1 of patent '846, it is not patentably distinct from claim 1 of patent '846. **With respect to claim 2 of the current application**, the limitations can be found in claim 2 of patent '846. **With respect to claim 3 of the current application**, the limitations can be found in claim 3 of patent '846. **With respect to claim 4 of the current application**, the limitations can be found in claim 4 of patent '846. **With respect to claim 5 of the current application**, the limitations can be

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found in claim 5 of patent '846. **With respect to claim 6 of the current application**, the limitations can be found in claim 6 of patent '846. **With respect to claim 7 of the current application**, the limitations can be found in claim 6 of patent '846. **With respect to claim 8 of the current application**, the limitations can be found in claim 10 of patent '846. **With respect to claim 9 of the current application**, the limitations can be found in claim 11 of patent '846. **With respect to claim 10 of the current application**, the limitations can be found in claim 12 of patent '846. **With respect to claim 11 of the current application**, the limitations can be found in claim 9 of patent '846. **With respect to claim 12 of the current application**, the limitations can be found in claim 8 of patent '846. **With respect to claim 13 of the current application**, the limitations can be found in claim 13 of patent '846. **With respect to claim 14 of the current application**, the limitations can be found in claim 14 of patent '846. **With respect to claim 15 of the current application**, the limitations can be found in claim 15 of patent '846. **With respect to claim 16 of the current application**, the limitations can be found in claim 16 of patent '846. **With respect to claim 17 of the current application**, the limitations can be found in claim 17 of patent '846. **With respect to claim 18 of the current application**, the limitations can be found in claim 18 of patent '846. **With respect to claim 19 of the current application**, the limitations can be found in claim 19 of patent '846. **With respect to claim 20 of the current application**, the limitations can be found in claim 20 of patent '846. **With respect to claim 21 of the current application**, the limitations can be found in claim 21 of patent '846. **With respect to claim 22 of the current application**, the difference between claim 22 of the application and claim 22 of patent '846 is the fact that the patent claim includes many more elements and is thus much more specific. Thus the invention of claim 22 of patent '846 is

in effect “specie” of the “generic” invention of claim 22 of the application. It has been held that the generic invention is “anticipated” by the “specie”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 22 of the application is anticipated by claim 22 of the patent ‘846, it is not patentably distinct from claim 22 of the patent ‘846. **With respect to claim 23 of the current application**, the limitations can be found in claim 23 of patent ‘846. **With respect to claim 24 of the current application**, the limitations can be found in claim 24 of patent ‘846. **With respect to claim 25 of the current application**, the limitations can be found in claim 28 of patent ‘846. **With respect to claim 26 of the current application**, the limitations can be found in claim 29 of patent ‘846. **With respect to claim 27 of the current application**, the limitations can be found in claim 30 of patent ‘846. **With respect to claim 28 of the current application**, the limitations can be found in claim 25 of patent ‘846. **With respect to claim 29 of the current application**, the limitations can be found in claim 26 of patent ‘846. **With respect to claim 30 of the current application**, the limitations can be found in claim 27 of patent ‘846. **With respect to claim 31 of the current application**, the limitations can be found in claim 31 of patent ‘846. **With respect to claim 32 of the current application**, the limitations can be found in claim 32 of patent ‘846. **With respect to claim 33 of the current application**, the limitations can be found in claim 33 of patent ‘846. **With respect to claim 34 of the current application**, the limitations can be found in claim 34 of patent ‘846. **With respect to claim 35 of the current application**, the limitations can be found in claim 35 of patent ‘846. **With respect to claim 36 of the current application**, the limitations can be found in claim 36 of patent ‘846. **With respect to claim 37 of the current application**, the limitations can be found in claim 37 of patent ‘846. **With respect to claim 38 of the current application**, the difference

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between claim 38 of the application and claim 38 of patent '846 lies in the fact that patent claim includes many more elements and is thus much more specific. Thus the invention of claim 38 of patent '846 is in effect a "specie" of the "generic" invention of claim 38 of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 38 of the application is anticipated by claim 38 of patent '846, it is not patentably distinct from claim 38 of patent '846. **With respect to claim 39 of the current application**, the difference between claim 39 of the application and claim 39 of patent '846 lies in the fact that patent claim includes many more elements and is thus more specific. Thus the invention of claim 39 of patent '846 is in effect a "specie" of the "generic" invention of claim 39 of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 39 of the application is anticipated by claim 39 of patent '846, it is not patentably distinct from claim 39 of patent '846. **With respect to claim 40 of the current application**, the difference between claim 40 of the application and claim 40 of patent '846 lies in the fact that patent claim includes many more elements and is thus much more specific. Thus the invention of claim 40 of patent '846 is in effect a "specie" of the "generic" invention of claim 40 of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claim 40 of the application is anticipated by claim 40 of patent '846, it is not patentably distinct from claim 40 of patent '846.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nihir Patel whose telephone number is (571) 272-4803. The examiner can normally be reached on 7:30 to 4:30 every other Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nihir Patel
October 20th, 2005



Henry Bennett
Supervisor, Patent Examiner
Group 2760